



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,263	03/01/2004	Hironobu Takizawa	17489	4220

23389 7590 01/30/2006

SCULLY SCOTT MURPHY & PRESSER, PC
400 GARDEN CITY PLAZA
SUITE 300
GARDEN CITY, NY 11530

EXAMINER

SMITH, PHILIP ROBERT

ART UNIT	PAPER NUMBER
----------	--------------

3739

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

87

Office Action Summary	Application No.	Applicant(s)	
	10/790,263	TAKIZAWA ET AL.	
	Examiner	Art Unit	
	Philip R. Smith	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 3, 5, 6, 8-12, 15, 17 and 29-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 7, 13, 14, 16 and 18-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/20/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Elections

- [01] Claims 3, 5-6, 8-12, 15, 17 & 29-52 are withdrawn without traverse from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group or species, as per the correspondence of 12/5/2005.

Specification

- [02] The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the elected claims are directed.

Claim Rejections - 35 U.S.C. 112, Paragraph Two

- [03] The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- [04] Claim 1 recites "the detecting result." There is insufficient antecedent basis for this limitation in the claim. Presumably, for the purposes of applying art, "the detecting result" refers to the detected evacuated detected by the detecting device.
- [05] Claims 21 & 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. They are indefinite at least for reasons of grammar, rendering the scope of the claims unclear.
- [06] Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

Art Unit: 3739

applicant regards as the invention. Applicant recites a "detecting device for *extracorporeally detecting* position specifying information." It is unclear what exactly is being described as extracorporeal, given that the capsule medical apparatus is intended for "detecting in-vivo information."

[07]

Claim Rejections - 35 USC § 102

[08] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

[09] Claims 1-2, 4, 7, 13-14, 16, & 18-28 are rejected under 35 U.S.C. 102(a) as being anticipated by Lewkowicz et al (2003/0114742).

[10] With regard to claim 1: Lewkowicz discloses a capsule medical apparatus for medical actions such as examination and treatment in the body, the capsule medical apparatus ("in vivo device 20," [0029]) comprising:

[10a] a detecting device ("steerable transceiver 27," [0033]) which is inherently capable of detecting whether the capsule medical apparatus is just being evacuated from the body, or it has already been evacuated, or if it is extracorporeally evacuated ("The location and/or position of the in vivo device 20 can be determined..."); and

[10b] a notifying device ("processing unit," [0031]) which extracorporeally notifies the detecting result, in association with the detecting device ("The processing unit may be triggered by any of these environmental conditions [location or position of the device ... in vivo pH or temperature] to communicate a command, as described above, and a signal may be induced accordingly," [0031]).

[11] With regard to claims 2 & 14: Lewkowicz discloses a capsule medical apparatus for medical actions such as examination and treatment in the body, the capsule medical apparatus ("in vivo device 20," [0029]) comprising:

[11a] a detecting device ("steerable transceiver 27," [0033]) which is inherently capable of detecting whether the capsule medical apparatus is extracorporeally evacuated ("The location and/or position of the in vivo device 20 can be determined..."). Extracorporeal evacuation constitutes a set medical action.

[11b] a notifying device ("white LEDs 23A and 23B," [0028]) which inherently capable of externally notifying the extracorporeal evacuation. The notifying device is associated with the detecting device, as they are both components of the same device.

[12] With regard to claims 4 & 16: The notifying device disclosed by Lewkowicz is a light emitting device.

[13] With regard to claim 7: The device disclosed by Lewkowicz inherently has

structures with stoppable functions. These structures are associated with the notifying device and its operation.

[14] With regard to claim 13: Lewkowicz discloses

[14a] an image pick-up element ("image sensor 24") for capturing an image;

[14b] an illuminating device ("white LEDs 23A and 23B," as noted above) for illuminating a photographing target; and

[14c] a light emitting device for notifying the extracorporeal evacuation (as noted above) wherein the light emitting device is shared with an illuminating device for photographing an image.

[15] With regard to claim 18: Lewkowicz discloses a detecting device ("steerable transceiver 27," as noted above) for detecting the completion of the set medical action (for example, steering in vivo) and a notifying device ("processing unit," as noted above) for externally notifying the extracorporeal evacuation in association with the detecting device. The mode disclosed by Lewkowicz in which the medical action (steering in vivo) takes place is an operating mode; the mode disclosed by Lewkowicz in which the medical action ceases (steering ceases) is a standby mode; the notifying device disclosed by Lewkowicz ("processing unit," as noted above) operates during the standby mode.

[16] With regard to claim 4, 13 & 16: Lewkowicz discloses

[16a] An image pick-up element for capturing an image;

[16b] an illuminating device for illuminating a photographing target;

[16c] wherein the notifying device (as noted above) is a light emitting device arranged to the capsule medical apparatus;

[16d] wherein the light emitting device is shared with an illuminating device for photographing an image.

[17] With regard to claims 19-20 & 22-23: As noted above, Lewkowicz discloses a medical action (steering in vivo) which occurs during an operating mode and an extracorporeal detecting mode for detecting (with the "processing unit, as noted above) that the capsule medical apparatus is extracorporeally evacuated ("location or position of the device," [0031], as noted above), or in the case of substantially evacuating the capsule medical apparatus to the body outside. As noted above, Lewkowicz further discloses that a notifying device ("processing unit") performs a notification in a notifying mode.

[18] With regard to claims 21 & 24: Processing units such as that disclosed by Lewkowicz inherently have operating times that can be set.

[19] With regard to claim 25: As noted above, Lewkowicz discloses a capsule medical apparatus ("in vivo device 20," [0029]) for passing a capsule casing through the living body and detecting in-vivo information, the capsule medical apparatus comprising in the casing:

[19a] a detecting device for extracorporeally detecting position specifying information indicating the position of the casing and a determining device for determining based on the position specifying information detected by the

detecting device whether or not the casing is positioned in the large intestine ("steerable transceiver," as noted above); and

[19b] a notifying device for extracorporeally outputting a notifying signal when the determining device determines that the casing is positioned in the large intestine ("In another case, environmental conditions, such as in vivo pH or temperature, as determined by an in vivo sensor, may indicate that it is desirable for the in vivo device to be slowed down for further inspection of the specific site," [0032]).

[20] With regard to claim 26: Lewkowicz discloses that the position specifying information is extracorporeally supplied (from the "processing unit," as noted above).

[21] With regard to claim 27: Lewkowicz discloses a capsule medical apparatus collecting system having a capsule medical apparatus for passing a capsule casing ("in vivo sensor 20," as noted above) through the living body and for detecting living body information and an extracorporeal device extracorporeally arranged, the capsule medical apparatus comprising in the casing:

[21a] a detecting device for detecting position specifying information indicating the position of the casing that is extracorporeally supplied and a determining device for determining based on the position specifying information detected by the detecting device whether or not the casing is positioned in the large intestine ("steerable transceiver 27," as noted

above); and

[21b] a notifying device for extracorporeally outputting a notifying signal (sent to the processing unit: "location or position of the device may be determined, for example by the processing unit," [0031]) when the determining device determines that the capsule casing is positioned in the large intestine,

[21c] and the extracorporeal device comprising:

[21d] a supply device for supplying the position specifying information, a receiving device for receiving the notifying signal and an output device for outputting sensible information based on the notifying signal ("processing unit," as noted above, which "[determines] the location or position of the device," "transmit[s] a signal appropriate for steering the in vivo device," etc. [0031])

[22] With regard to claim 28: Lewkowicz further discloses that the position specifying information is electric waves ("If the location or position of the device is undesired (e.g., the device is facing and sensing one wall of a body lumen whereas it is desired to sense other walls of the body lumen) the processing unit can communicate a command, such as an electric or any other suitable (such as microwave, IR etc.) signal, to a processor in the signal source to transmit a signal having a vector and/or amplitude appropriate for steering the in vivo device in a desired direction or to a desired location and/or position," [0031])

Conclusion

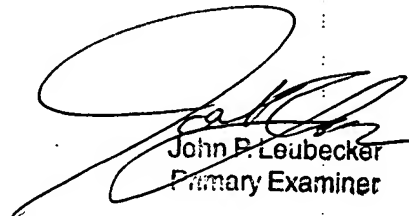
[23] The prior art made of record and not relied upon is considered pertinent to

Art Unit: 3739

applicant's disclosure. Ueda (5681260), Frisch (6904308), Takizawa (2003/0020810) and Fukuda (2004/0210131) disclose a transmitting capsule endoscope with a known position.

- [24] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip R. Smith whose telephone number is (571) 272 6087 and whose email address is philip.smith@uspto.gov. The examiner can normally be reached between 9:00am and 5:00pm.
- [25] If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272 4764.
- [26] Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

[27] Prs


John P. Leubecker
Primary Examiner